

REMARKS

New independent Claim 25 and dependent Claims 26 and 27 are added. Claims 1, 7-11, and 18-27 remain, with no claim previously allowed.

Claims 1, 7-8, 10-11, 18-19, and 21-24 were rejected as being unpatentable over *Munsil* (US 5,761,651) in view of newly-cited *Kovac* (US 6,988,277). The applicant respectfully traverses this rejection.

Munsil discloses generating a customer billing statement including notices and messages, which may be based on criteria relevant for a particular customer or without regard to individual customer information. The rejection acknowledges that *Munsil* does not teach wherein the customer can opt not to receive any-billing information. However, *Kovac* is cited as teaching that it was known in the art to offer users an option to either receive or not receive advertising. The rejection concludes that it would have been obvious to modify the customer preference table of *Munsil* to include a category by which users can opt to either receive or not receive billing information as allegedly taught by *Kovac*. The applicant respectfully traverses the Examiner's interpretation of *Kovac*, as well as the rejection based on that combination of references.

Munsil is concerned with generating billing statements that are printed and mailed to a customer (column 1, lines 28-30; column 2, lines 4-13). *Munsil* accomplishes that objective by assembling billing statements, with qualifying messages and notices grouped together and printed on the bill according to a certain priority (column 12, lines 55-58 and 62-64).

Kovac, in contrast with *Munsil*, discloses distribution of video or audio programming of a kind customarily interrupted at intervals with commercials. However, *Kovac* would allow the viewer, for a fee, to choose to group and view all the advertising at the beginning or end of the program, or for alternative presentations of the advertisements during distribution of the

programming material (column 2, lines 1-8). In other words, *Kovac* lets the program viewer opt to make a direct payment for viewing a selected program with advertising repositioned to prevent commercial interruption, instead of viewing the advertising (a kind of indirect payment) that otherwise would interrupt the programming. However, a careful reading of *Kovac* shows that "the user is always exposed to [advertising]" (column 2, lines 32-33, emphasis added, and lines 53-54). That secondary reference enables the user, for a fee, to reposition advertising or modify the form (column 2, lines 4-6) of advertising relative to the program material, but does not let the user avoid the advertising. Accordingly, a hypothetical combination of *Munsil* and *Kovac* would fail to provide a billing method including giving the customer an option not to receive any non-billing information, as required by Claim 1.

Moreover, the objective and result disclosed by *Kovac*, namely, optional commercial-uninterrupted viewing of programs for a fee, would not be compatible with a billing system as in *Munsil*. It is not likely, to say the least, that a customer being billed by a vendor per *Munsil* for services or goods would elect to pay a further amount, in addition to that billing, to receive a bill without any non-billing information. Furthermore, in *Kovac* the programming material is something the customer presumably looks forward to experiencing and might choose to enhance that experience by paying a fee for advertising-uninterrupted viewing or listening. Receiving an invoice is not such an experience, and it is likely that most customers would be angry if their billing vendors tried to extract an additional fee for presenting bills free of non-billing information.

Kovac points out that commercial programming is paid for by embedded advertising (column 1, lines 18-29), and discloses an alternative way for viewers to pay for that programming. However, while billers who include non-billing information (for example,

promoting additional goods/services) may seek additional revenue from customers, that non-billing information does not pay for something the customer is receiving; the billing information itself represents payment for goods or services supplied by the biller. For this further reason, one of ordinary skill would not have sought to combine *Kovac* with *Munsil* in any way relevant to Claims 1 et al. Accordingly, those claims are patentable thereover.

The rejection also acknowledges that *Munsil* does not teach positioning the non-billing information between a customer identifier located at the beginning of the communication and a billing amount located at the end of the communication. However, the Examiner contends that the applicant's claimed placement of non-billing information is "an aesthetic design choice" relating to ornamentation only, which cannot be relied upon to patentably distinguish from the prior art. The rejection cites *In re Seid*, 73 USPQ 431(CCPA 1947) for support. Regarding the applicant's disclosure that changing the location of billing information "may induce a customer to read non-billing information while searching for the billing information...", the Examiner argues that "may" amounts to an admission that such dynamic positioning of the non-billing information is not a critical feature of the present invention and holds no functional importance. The applicant respectfully traverses that position taken by the Examiner and repeats the arguments on pages 8-10 of the Third Response filed June 3, 2005 concerning *In re Seid*.

Further addressing the issue of functional importance, the applicant invites the Examiner's attention to the enclosed definition of "may" from *dictionary.com*. "May", used as an auxiliary verb, has several meanings. Among those meanings is "to indicate a certain measure of likelihood or possibility" and "to express contingency, purpose, or result...".

The context in which the applicant uses "may" must determine the applicant's intended meaning of that word to one of ordinary skill. This context appears in full paragraph [0007] beginning at line 15 of page 2, as follows:

"Another object of the invention is to increase the likelihood that information would be successfully conveyed to a customer by including the bill with the non-billing information. In addition, in one embodiment, the billing information is not always located in the same area of the newsletter. This may induce a customer to read non-billing information while searching for the billing information, particularly since the information is tailored to the customer." (emphasis added)

The applicant thus discloses an object of his invention, and in the next sentence discloses an embodiment for achieving that object. That disclosed embodiment is not always locating the billing information in the same area of the newsletter, i.e., dynamic positioning of the billing information. The paragraph [0007] next expresses the purpose or result of that embodiment, namely, that it "may induce a customer to read non-billing information while searching for the billing information...". The applicant submits that using "may", in the context of a paragraph disclosing an object of the present invention and an embodiment for achieving that object, gives *prima facie* meaning and direction to the intended functional importance of dynamic placement for the billing information. Given that disclosure by the applicant, the Examiner's unsupported assertion that "it's as likely that the dynamic placement may not induce a customer to read the non-billing information" is speculative at best, is insufficient to overcome the applicant's *prima facie* disclosure of significance, and cannot support a conclusion that the limitation is only a matter of aesthetic design choice.

The mere possibility that the claimed dynamic placement may not *always* induce customers, or *every* customer, to read the non-billing information does not detract from the functional intent and purpose of that dynamic placement. To hold otherwise would amount to holding patent applicants to a subjective standard of 100% certainty that their inventions must always satisfy the objects of those inventions, a requirement of perfection not found in the patent statutes.

Furthermore, *In re Seid* does not support the Examiner's position that the applicant's claimed method relates to ornamentation only. In *Seid*, the applicant claimed an apparatus, namely, the shape and arrangement of a human figure at the neck of a bottle. The Court, finding that the claimed structural shape and arrangement of that figure related to ornamentation only, held that those structural features cannot be relied on, "as the appealed claims... are structural claims". However, Claims 1, 7-9, 21, and 25-27 are method or system claims. These claims do not seek to define a particular structure of a customer bill, but instead define a method or system for communicating with customers. That method or system includes changing the location of billing information relative to non-billing information in at least one prior customized communication, so as to induce the customer to read the non-billing information while searching for the billing information. That limitation, in the overall combinations defined by those claims, is entitled to consideration on the merits, including a determination of novelty and unobviousness vs. the prior art. Nothing in *Munsil*, alone or in combination with *Kovac*, would have led one of ordinary skill to the claimed method or system. That invention comes only from the present applicant, not from the applied references.

New independent Claim 25 includes the limitation:

"positioning the non-billing information within the customized communication at a location relative to the location of the billing information in the customized communication that varies from location of the non-billing information relative to the billing information in at least one prior customized communication to the customer, whereby the billing information is not always in the same area of the customized communications, so as to induce the customer to read the non-billing information while searching for the billing information".

New dependent Claim 27 adds the same limitation to Claim 1.

That element of the invention defined in new independent Claim 25 and in dependent Claims 26 and 27, is novel over *Munsil* (US 5,761,650) and would not have been obvious to one of ordinary skill in view of that reference. *Munsil* is silent as to positioning the non-billing information relative to a billing amount. Moreover, nothing in that reference would suggest, to one of ordinary skill, changing the location of billing information relative to non-billing information so that the billing information is not always in the same area of the communication to the customer.

New Claim 26 depends from Claim 25 and adds that the customer identifier is positioned at a fixed location at the beginning of a customized communication. The location of a customer identifier in the communication thus does not vary, although the positioning of non-billing information does vary relative to the location of the billing information in at least one prior customized communication. The method of Claim 26 is thus novel and unobvious over the art of record.

The foregoing is submitted as a complete response to the Office action identified above.

The applicant respectfully submits that all claims in this application are patentable over the art of record and solicits a notice to that effect.

Respectfully submitted,

MERCHANT & GOULD


Roger T. Frost
Reg. No. 22,176

Date: July 24, 2006

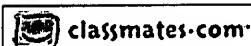
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may

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Top Web Results for "may"**10 entries found for *may*.****May, Cape**

A peninsula of southern New Jersey between the Atlantic Ocean and Delaware Bay. The southern tip forms **Cape May Point**.

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may²  **Pronunciation Key** (mā)*n. Chiefly British*

The blossoms of the hawthorn.

[French *mai*, *hawthorn*, from *Mai*, *May* (*so called because it blooms in May*). See **May**.]

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may¹  **P** **Pronunciation Key** (mā)
aux.v. *Past tense* **might** (mīt)

1. To be allowed or permitted to: *May I take a swim? Yes, you may.*
2. Used to indicate a certain measure of likelihood or possibility: *It may rain this afternoon.*
3. Used to express a desire or fervent wish: *Long may he live!*
4. Used to express contingency, purpose, or result in clauses introduced by *that* or *so that*: *expressing ideas so that the average person may understand.*
5. To be obliged; must. Used in statutes, deeds, and other legal documents. See *Usage Note at can¹.*

[Middle English, *to be able*, from Old English mæg, first and third person sing. of magan, *to be strong, be able*. See magh- in Indo-European Roots.]

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May  **P** **Pronunciation Key** (mā)

n.

1. The fifth month of the year in the Gregorian calendar. See table at [calendar](#).
2. The springtime of life; youth.
3. The celebration of May Day.

[Middle English, from Old French Mai, from Latin Māius (mēnsis), (*the month*) of Maia, goddess. See meg- in Indo-European Roots.]

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might¹  **P** **Pronunciation Key** (mīt)

n.

1. The power, force, or influence held by a person or group.
2. Physical strength.
3. Strength or ability to do something. See *Synonyms at strength*. See *Regional Note at powerful*.



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[Middle English, from Old English *meaht*, *miht*. See *magh-* in Indo-European Roots.]

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might²  **Pronunciation Key** (mīt)

aux.v. *Past tense of may*

- a. Used to indicate a condition or state contrary to fact: *She might help if she knew the truth.*
- b. Used to indicate a possibility or probability that is weaker than *may*: *We might discover a pot of gold at the end of the rainbow.*
- 2. Used to express possibility or probability or permission in the past: *She told him yesterday he might not go on the trip.*
- 3. Used to express a higher degree of deference or politeness than *may*, *ought*, or *should*: *Might I express my opinion?*

[Middle English, from Old English *meahte*, *mihte*, first and third person sing. past tense of *magan*, *to be able*.

See **may¹**.]

Our Living Language In many Southern U.S. varieties of English, *might* can be paired with other auxiliary verbs such as *could*, as in *We might could park over there*. Words like *might* and *could* are known as *modals*, since they express certain “moods” (for example, *I might go* indicates an uncertain mood on the part of the speaker). Combinations such as *might could*, *might would*, and *might can* are known as *double modals*. Other less common combinations include *may can*, *may will*, and *might should*. Since double modals typically begin with *may* or *might*, they lessen the degree of conviction or certainty (much like the word *possibly*) more than a single modal does. Double modals are used, for example, to minimize the force of what one is saying, as when asking someone for a favor or when indicating displeasure. Although double modals may sound odd outside of the South, they carry little if any social stigma within the South and are used by speakers of all social classes and educational levels—even in formal instances like political addresses. Like many features of Southern varieties of English, the use of double modals is probably due to the fact that many of the first English speakers in the South were Scotch-Irish, whose speech made use of double modals. This feature has been noted as far back as the Middle English period, but today's most common forms were not used to any great extent until the mid-18th century. They are surprisingly rare in dialect fiction but do occasionally occur, as in *Old Yeller* by Fred Gipson: “*Jumper's liable to throw a fit with that hide rattling along behind him, and you might not can hold him by yourself.*”

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may

see be that as it may; come what may; let the chips fall where they may; to whom it may concern.

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may

n 1: the month following April and preceding June [syn: May] 2: thorny Eurasian shrub of small tree having dense clusters of white to scarlet flowers followed by deep red berries; established as an escape in eastern North America [syn: whitethorn, English hawthorn, Crataegus laevigata, Crataegus oxyacantha]

Source: *WordNet® 2.0*, © 2003 Princeton University

may, OK (town, FIPS 47000)

Location: 36.61650 N, 99.74896 W

Population (1990): 42 (34 housing units)

Area: 0.5 sq km (land), 0.0 sq km (water)

Zip code(s): 73851

may, TX

Zip code(s): 76857

Source: *U.S. Gazetteer, U.S. Census Bureau*

may

MAY: in Acronym Finder

Source: *Acronym Finder*, © 1988-2004 Mountain Data Systems

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